

REMARKS

In the Office Action dated November 14, 2005, claims 1-22 were canceled and claims 23-33 were presented for examination. The Examiner rejected claim 23 under 35 U.S.C. §112, first paragraph, and rejected claim 24 under 35 U.S.C. §112, second paragraph. In addition, the Examiner rejected claims 23-33 under 35 U.S.C. §103(a).

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of November 14, 2005 for the pending application.

I. Interview with Examiner Lu

On January 26, 2006 Applicant's Attorney met with Examiner Lu for an interview to discuss the elements of the rejection presented in the Office Action dated November 14, 2005. Applicant's Attorney and Examiner Lu discussed the amendment to claim 23 made in response to the Non-Final Office Action. More specifically, Applicant's Attorney indicated how the formula amended into the body of the independent claim clearly defines Applicant's invention, and that the prior art does not teach this specific formula. Examiner Lu agreed that the formula amended into claim 23 more clearly defines Applicant's invention, but is concerned that this formula is known, although it may not be known to be applied in the manner as claimed by Applicant. The Examiner indicated that he believes that there is allowable subject matter in the application and proposed that Applicant further amend claim 23 with subject matter from one of claims 25, 27, or 32. Based upon the meeting with Examiner Lu, Applicant has amended claim 23 to include the subject matter of claims 25 and 27, and has added one additional independent claim to combine the elements of claim 23 and subject matter pertaining to compiling a list of common names based upon the measured proximity to further define the invention as discussed. Accordingly, Applicant now believes that this application is now in condition for allowance.

II. Rejection of claim 23 under 35 U.S.C. §112, first paragraph

The Office Action of November 14, 2005 rejects claim 23 under 35 U.S.C. §112, first paragraph, as indicating the claimed invention is incomplete for omitting essential steps. Applicant has amended claim 23 to include additional matter with respect to the step of measuring proximity between the first and second libraries. Applicant's Attorney and Examiner Lu discussed this rejection on the interview of January 26, 2005, and Examiner Lu indicated this amendment to claim 23 would overcome this rejection. Accordingly, Applicant respectfully request removal of the rejection of claim 23 under 35 U.S.C. §112, first paragraph.

III. Rejection of claim 24 under 35 U.S.C. §112, second paragraph

The Office Action of November 14, 2005 rejects claim 24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 24 to define where the data is forwarded to based upon the measured proximity. Based upon the amended language of claim 24, Applicant requests removal of the rejection of claim 24 under 35 U.S.C. §112, second paragraph.

IV. Rejection of claims 23-33 under 35 U.S.C. §103(a)

The Office Action of November 14, 2005 rejects claims 23-33 under 35 U.S.C. §103(a) as being unpatentable over *Tsutsumi et al.* (U.S. Patent No. 5,812,998) in view of *Singhal* (U.S. Patent No. 6,163,782) and further in view of *McGee et al.* (U.S. Patent No. 6,496,228).

Applicant's remarks to *Tsutsumi et al.*, *Singhal*, and *McGee et al.* provided in the response to the First, Second, and Third Office Actions are hereby incorporated by reference.

With respect to claim 23, the Examiner combines *Tsutsumi et al.* with *Singhal* to teach all of the elements of the claim with the exception of the mathematical formula. The Examiner then borrows the *McGee et al.* patent to teach the elements of claim 23 pertaining to the mathematical formula. As noted by the Examiner, the combined teaching of *Singhal* and *Tsutsumi et al.* does not specifically teach assigning a standard proximity between the ranking of names in the first and second libraries. See Third Office Action, page 7. The Examiner then borrows *McGee et al.* to teach a formula for summing an absolute value of a difference between pairs of coefficients of current and previous frames. See Third Office Action, page 7.

However, the formula as taught in *McGee et al.* is not the same formula as claimed by Applicant. Applicant's claimed mathematical formula extends beyond the summation of the absolute difference between ranking of names in libraries. Applicant's formula includes a factor ($1/n$) associated with the quantity of names in the libraries. This factor is not present anywhere in *McGee et al.* "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Although it may be "obvious" to modify *McGee et al.* to incorporate the factor of Applicant ($1/n$), *McGee et al.* does not teach use of this factor associated with the summation of the absolute difference. The prior art must teach all of the elements in the claims. *McGee et al.* teaches use of a formula for summation of an absolute difference, but not a formula that implements a factor associated therewith based on the quantity of names in the libraries. If *McGee et al.* had wanted to use such a factor, then *McGee et al.* would have done so. The fact that *McGee et al.* does not use such a factor for the use claimed by Applicant should serve as evidence that *McGee et al.* does not teach or suggest this claimed limitation.

Furthermore, *McGee et al.* does not pertain to measuring proximity between a first library and a second library. The Examiner uses *McGee et al.* to support use of the mathematical formula. However, the *McGee et al.* patent does not pertain to the claimed subject matter, namely measuring proximity between libraries. The Court of Appeals for the Federal Circuit has long held that "[i]t is impermissible to use the claimed invention as an instruction manual or

'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet that is the very process that the Examiner has undertaken. *McGee et al.* does not show, teach, or suggest implementing their mathematical formula for measuring proximity between libraries. Courts have long recognized that most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. The Court of Appeals for the Federal Circuit has stated that:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed invention would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

In re Rouffet, 149 F. 3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (citing *Sensonic, Inc. Aerosonic Corp.*, 81 F.2d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). In the present case, as one would naturally expect, the Examiner is finding some of the elements of Applicant's invention in various prior art patents. However, the Examiner goes further in the present case by then using the Applicant's claimed invention as a template to combine the elements found in the prior art in a way neither found in the prior art nor even functional in the prior art. It speaks to the novel nature of Applicant's invention that when Applicant's claimed invention is viewed in its entirety it is greater than the sum of its parts and combines to form an invention that produces an improvement over the prior art systems. Accordingly, the Applicant respectfully contends that the combination of *Tsutsumi et al.* in view of *Singhal* and further in view of *McGee et al.* does not, and can not, meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests the removal of the rejection of claims 23-24.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly,

Applicant requests that the Examiner indicate allowability of claims 23-44, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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